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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL MCALEESE, ROBERT E. CARMACK,
and CLETUS M. TURNER

Appeal 2014-006940
Application 12/769,997¹
Technology Center 3600

Before BIBHU R. MOHANTY, BRUCE T. WIEDER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–11. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION.

¹ According to the Appellants, the real parties in interest are The Kroger Co. and i-wireless, LLC. Appeal Br. 2.

ILLUSTRATIVE CLAIM

1. A method for providing retail customers with multiple reward types based upon in-store purchases, the method comprising:

monitoring customer in-store purchases utilizing an in-store point-of-sale computer system and awarding customer points based upon such in-store purchases;

storing both (i) cumulative customer point data and (ii) customer point transaction data in a customer database, the customer point transaction data including transaction date and time data;

accessing the cumulative customer point data to determine a first customer reward applicable to purchase of a specific product, the first customer reward triggered by identification of the customer's intent to purchase the specific product; and

periodically transferring new customer point transaction data to a third party computer system for use by the third party computer system in identifying a second customer reward applicable to use of a customer mobile phone, such that customer points earned by the customer for in-store purchases are used to define two distinct reward types for the customer.

REJECTIONS²

I. Claims 1, 8, 9, and 11 are rejected under 35 U.S.C. § 102(e) as anticipated by Breznik et al. (US 2009/0138302 A1, pub. May 28, 2009) (“Breznik”).

II. Claims 2–6, and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Breznik.

² This statement of the rejections reflects the Examiner's position provided in the Final Action, in view of the clarifications set forth on page 3 of the Answer.

III. Claim 7 is rejected under 35 U.S.C. § 103(a) as unpatentable over Breznik and Smith et al. (US 2004/0249710 A1, pub. Dec. 9, 2004) (“Smith”).

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

As a procedural matter, the Appellants contend that it was improper for the Advisory Action to make corrections to the rejections set forth in the Final Office Action. Appeal Br. 4–5.

On the contrary, the rules expressly contemplate such modifications. *See* 37 C.F.R. § 41.39(a)(1) (referring to “the grounds of rejection set forth in the Office action from which the appeal is taken” being “modified by any advisory action”). Indeed, the rules state that the Examiner’s Answer is deemed to incorporate all such modifications and may even set forth new grounds of rejection and that an appellant may request that prosecution be reopened, in response thereto. *See* 37 C.F.R. § 41.39(a), (b).

Accordingly, we turn to the Appellants’ substantive arguments.

Independent Claim 1 and Dependent Claims 2–9

The Appellants (Appeal Br. 7–8) argue that Breznik lacks the following limitation of independent claim 1:

accessing the cumulative customer point data to determine a first customer reward applicable to purchase of a specific product, the first customer reward triggered by identification of the customer’s intent to purchase the specific product.

The Final Office Action (on page 2) identified Breznik ¶ 67 as teaching the identified limitation.

The Appeal Brief disputes this finding (Appeal Br. 7–8), but the Examiner’s Answer states that Breznik ¶ 62 teaches that cumulative customer point data is accessed to determine a reward or credit and that Breznik ¶¶ 51–52 “teach that points can be used for future purchases and a future purchase is a consumer’s intent to buy.” Answer 3–4.

The Appellants’ Reply Brief contends that the “future retail purchases” discussed in Breznik ¶¶ 51–52 does not amount to the claimed “intent to purchase the specific product” and that the arrangement of prepaying money into a customer loyalty account or electronic wallet, in Breznik ¶¶ 51–52, does not describe the limitation at issue.

We agree with the Appellants. Notably, the cited portions of Breznik fail to disclose how any “reward” might be “triggered by identification of the customer’s intent to purchase the specific product,” as set forth in claim 1. In addition, the “future retail purchases” discussed in Breznik ¶ 51 and the “variety of different goods and services” discussed in Breznik ¶ 52 are not related to any “specific product” as the claim limitation requires.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(e) is not sustained.

For the same reason, we do not sustain the rejection of claims dependent upon claim 1, as the Examiner’s rejections of these dependent claims do not cure the deficiency in the Examiner’s rejection of claim 1. Specifically, the rejection of claims 8 and 9 under 35 U.S.C. § 102(e) is not sustained and the rejection of claims 2–7 under 35 U.S.C. § 103(a) is not sustained.

Independent Claim 10

In regard to independent claim 10, the Appellants argue (Appeal Br. 9–10, 13–14) that Breznik does not teach or suggest the following limitation:

(c) tracking the customer transaction data in one or more stores of a second entity and transferring the customer transaction data to the first entity, wherein the second entity tracks total points earned in order to provide the customer with a fuel reward.

The Examiner's Answer (page 4) relies upon a different selection of paragraphs of Breznik than was set forth in the Final Office Action (at pages 5–7). According to the Examiner, Breznik ¶¶ 43 and 50 teach the tracking of customer transaction data because accrued points or credits are stored and linked to the purchase of particular products or services, Breznik ¶ 31 teaches using a mobile phone to make purchases (in place of accrued points), Breznik ¶ 50 teaches that accrued points can be applied as credit to a mobile phone bill, and Breznik ¶ 38 teaches using a mobile phone to purchase fuel. Answer 4. The Examiner determines that these combined teachings constitute the identified limitation of claim 10. *Id.* The Examiner also states that the phrase of claim 10 “wherein the second entity tracks total points earned in order to provide the customer with a fuel reward” reflects intended use and is “not necessarily” entitled to patentable weight. *Id.*

The Appellants criticize the Examiner's reasoning in the Answer as “contorted, circular and nonsensical,” but do not substantively address the Examiner's position. Reply Br. 6. In addition, but also without explanation, the Appellants contend that the Examiner's statement that the “wherein . . .” clause of claim 10 reflects “intended use” amounts to “further evidence that Breznik does not disclose or suggest such features” of the claim. *Id.* at 7.

We do not agree with the Examiner that the “wherein . . .” clause reflects intended use; rather, the claim language requires the provision of “a fuel reward.” Nevertheless, the Appellants’ critique of the Examiner’s position is not persuasive of error in the rejection of claim 10. Accordingly, the rejection of claim 10 under 35 U.S.C. § 103(a) is sustained.

Dependent Claim 11

Claim 11 depends from claim 10, further reciting: “wherein the first mobile plan type is a limited usage type plan and the second mobile plan type is an unlimited usage type plan.”

The Examiner finds that Breznik ¶ 44 teaches the limitation of claim 11, by teaching that mobile phone plans can be pre-paid and post-paid. Final Action 4–5.

The Appellants do not dispute this finding. Rather, the Appellants argue that the rejection of claim 11 must be reversed, based upon the arguments presented in regard to base claim 10 (Appeal Br. 10–11) and because claim 11 was rejected under 35 U.S.C. § 102(e) as anticipated by Breznik, whereas base claim 10 was rejected under 35 U.S.C. § 103(a) as obvious over Breznik (Reply Br. 4).

Although dependent claim 11 cannot be rejected properly as anticipated — because the Examiner does not explain how base claim 10 is anticipated (base claim 10 is rejected as obvious) — the Examiner’s findings and analysis demonstrates that claim 11 is obvious over Breznik. Accordingly, although the rejection of claim 11, under 35 U.S.C. § 102(e), must be reversed, we hereby set forth a new ground of rejection, under 35 U.S.C. § 103(a), that claim 11 is obvious over Breznik based upon the Examiner’s findings regarding claim 11, which we rely upon and adopt.

DECISION

We AFFIRM the Examiner's decision rejecting claim 10 under 35 U.S.C. § 103(a).

We REVERSE the Examiner's decision rejecting claims 1, 8, 9, and 11 under 35 U.S.C. § 102(e).

We REVERSE the Examiner's decision rejecting claims 2–7 under 35 U.S.C. § 103(a).

Claim 11 is newly rejected under 35 U.S.C. § 103(a).

New Ground of Rejection

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The

request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)